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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,707	04/08/2005	Bernd Zschke	268510US0PCT	6914

22850 7590 09/28/2006

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EXAMINER

COONEY, JOHN M

ART UNIT PAPER NUMBER

1711

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/530,707

Applicant(s)

ZASCHKE ET AL.

Examiner

John m. Cooney

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1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>0405</u> . | 6) <input type="checkbox"/> Other: ____ |

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: The title of the application is not set forth in the oath.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims are confusing as to intent because, while the terminology "capable" may be used in the language of the claim, in the instant case its use is objectionable to the degree that the claims are confusing as to intent. In the instant case the claims are reciting that the graft polyol is capable of being formed by a particular means. However, the graft polyol is already prepared, and stating how the polyol may be prepared when it is being defined by the claims as already prepared renders the claims confusing as to intent because it can not be determined what prepared polyols are intended to included or excluded by the metes and bounds of the claims.

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Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims are confusing as to intent because it can not be determined what particle size distributions are included or excluded by the metes and bounds of the claims.

Claim 8 is further confusing as to intent because it can not be determined what "two clearly separated maxima for the polymers" are intended to be defining. The "maximas" of the claim can not be determined if the "maximas" are not defined.

Claims 13-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language "obtainable by" (rather than "obtained by") as well as such allied terms as "derivable from", "preparable from", etc. fails to particularly point out and distinctly claim the invention since one can not determine from the phrase just which compositions are "obtainable by" applicants' processes and which are not.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 and 12 and 13 rejected under 35 U.S.C. 102(b) as being anticipated by Perry et al.(6,127,443).

Perry et al. discloses preparations of polyurethane foams prepared from crude MDI as defined by applicants' claims, polyols containing in situ formed polymers formed from ethylenically unsaturated monomers, catalysts, and blowing agents which read on the products and processes claimed (see the entire document). Amounts of polyol component and hydroxyl values of the polyols are values encompassed by ranges of amount values and the make-up defined by the polyols disclosed by Perry et al.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-11 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perry et al. as applied to claims 1-6 and 12-13 above, and further in view of EP-0,786,480 and Isobe et al.(6,433,033).

Perry et al. differs from applicants' claims in that it does not express particle distributions for their polymer polyols formed. However, EP-0,786,480 discloses employment of particle sizes in the range of applicants' claims and of narrow particle

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distributions to be well known for the purpose of obtaining stable polymer polyol dispersions for urethane synthesis (see the entire document). Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the stable dispersed polymer polyols of the narrow particle size distribution of EP-0,786,480 as the polymer polyols in the making of the preparations of Perry et al. for the purpose of obtaining stable polymer polyol dispersions for urethane synthesis in order to arrive at the products and processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results. It has long been held that where the general conditions of the claims are disclosed in the prior art, discovering the optimal or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233; *In re Reese* 129 USPQ 402 . Further, a prima facie case of obviousness has been held to exist where the proportions of a reference are close enough to those of the claims to lead to an expectation of similar properties. *Titanium Metals v Banner* 227 USPQ 773. **(see also MPEP 2144.05 I)** Similarly, it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272,205 USPQ 215 (CCPA 1980). EP-0,786,480 is not looked to for its teaching of polymer polyol mixtures as this feature is taught by the primary reference, Perry et al.

Claims additionally differ from Perry et al. in specific selection of initiators. However, Isobe et al. disclose the well known nature of the selection of diverse multifunctional materials as initiators in the making of polyols for urethane synthesis (see column 9 line 17 – column 11 line 33). Accordingly, it would have been obvious for

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one having ordinary skill in the art to have employed any of the diverse polyfunctional initiators embodied by the teachings of Isobe et al. in the preparations of Perry et al. for the purpose of imparting their polyoxyalkylene polyol initiating effect in order to arrive at the products and/or processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

Double Patenting

Claims 1-15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 10/507,315. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of 10/507,315 disclose preparations of polyurethane articles including those prepared by mixing and reacting isocyanates, polyols comprising blends of polymer polyols having bimodal polymer particle distributions, blowing agents, and catalysts. Looking to the specification of the 10/507,315 for isocyanates and polyols used for the practice of the invention of the claims of 10/507,315 reveals the selection of isocyanates and polyols of applicants' claims such that it would have been obvious for one having ordinary skill in the art to have employed the polyols provided for by the supporting disclosure of 10/507,315 for the purpose of imparting their known urethane group forming effects in order to arrive at the products and processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

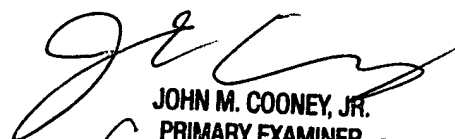
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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JOHN M. COONEY, JR.
PRIMARY EXAMINER
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